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4/3/09

In re Application of:
RAY, EDDIE F. III et al
Serial No.: 10/766,504
Filed: Jan. 27, 2004
Docket: 03190.000100.
Title: BONE GRAFTS

DECISION ON PETITION

This is a decision on the Petition for Suspension of Action received on March 20, 2009, seeking to suspend action on the above-identified application for a period of six months. This petition is being considered pursuant to 37 CFR § 1.103(a)¹. The requisite petition fee under 37 CFR § 1.17(g) was paid.

The petition is denied.

In the petition, petitioner alleged that the petition to suspend further action on the current application is to permit action by the PTO on Applicants' Request for Reexamination and for the PTO to make a consistent determination of patentability of the same or substantially the same claims to both parties.

The record shows:

- 1) On May 30, 2008, the examiner issued a non-final Office action.
- 2) On December 4, 2008, the applicant filed a response to the non-final Office action.
- 3) On December 4, 2008, the applicant filed the current petition to suspension office action for a period of six months.
- 4) On January 16, 2009, the petition was denied for failure to show good and sufficient reasons to delay prosecution.
- 5) On January 21, 2009, the examiner issued a final Office action rejecting all elected claims.
- 6) On March 20, 2009, the current petition seeking suspension of Office action is filed.

¹ 37 CFR 1.103. Suspension of action by the Office. (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include: (1) A showing of good and sufficient cause for suspension of action; and (2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office

In the petition, petitioner alleges that the request for reexamination SN 90/009,348 of the Ford Patent has been granted. A substantial new question of patentability of those very claims has now been found by the USPTO. In order to avoid inconsistent determination of patentability of those claims in the reexamination application, petitioner requests suspension of the current application for six (6) months to permit further action by the USPTO on the reexamination of the Ford Patent.

The reason for suspension of Office action is not justified. Under 37 CFR § 1.103(a), the Office will not suspend action if a reply by applicant to an Office action is outstanding. There was a final Office action mailed on January 21, 2009. The applicant must file a response to the final Office action of January 21, 2009 within the statutory period to respond. Therefore, the requested suspension will not be granted.

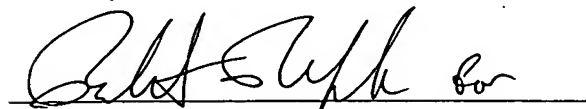
Furthermore, the reason for a six-month suspension of action is not convincing and could not justify a six-month delay in prosecution. As stated in the last decision, the Office must balance the burden of timely examinations and needs of the public to know which claims it faces with the needs of applicants in pursuing claims which reflect the scope to which they are entitled. Therefore, any suspension of Office action will not be granted without a good and sufficient cause. Since the application is under final, it would be more expeditious if the applicant would go forward to perfect the appeal so that a final patentability decision can be rendered by the Board of Appeals and Interference. Accordingly, the request is denied.

The application remains in active status and is being forwarded to the Supervisory Patent Examiner of Art Unit 3733 awaiting the applicant's Notice of Appeal and Appeal Brief in response to the final office action of January 21, 2009. As stated in 37CFR § 1.181(f): The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181" and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02(b).

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DENIED.

A handwritten signature in dark ink, appearing to read "Donald T. Hajec", is written over a horizontal line.

Donald T. Hajec, Director
Technology Center 3700